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| APPLICATION NO.         | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------|-------------|----------------------|---------------------|------------------|
| 10/016,242              | 10/30/2001  | Shigeru Yokono       | 112857-250          | 7869             |
| 29175                   | 7590        | 10/04/2005           | EXAMINER            |                  |
| BELL, BOYD & LLOYD, LLC |             |                      | TRAN, PHILIP B      |                  |
| P. O. BOX 1135          |             |                      | ART UNIT            | PAPER NUMBER     |
| CHICAGO, IL 60690-1135  |             |                      | 2155                |                  |
| DATE MAILED: 10/04/2005 |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/016,242             | YOKONO ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Philip B. Tran         | 2155                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 October 2001.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 27-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 27-29 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

**DETAILED ACTION*****Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 27-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, the claimed invention lacks patentable utility, and the disclosed invention is inoperative and therefore lacks utility.

"Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See

***Diamond v. Diehr, 450 U.S. 175, 185-86*** (noting that the claims for an algorithm in ***Benson*** were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance. ***In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978)*** ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on

words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in *Abele, 684 F.2d at 907, 214 USPQ at 687*). See also *In re Johnson, 589 F2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978)* ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. 101.

Regarding claims 27-29, claims 27-29 describe a recording medium comprising a first recording area, a second recording area, a third recording area and a fourth recording area in which information can be recorded. This type of claim does not meet statutory requirements as set forth in the MPEP § 2106. These claims do not require any interaction with associated hardware or functional state change of associated hardware components required for statutory compliance. Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such

descriptive material alone does not impart functionality either to the data as so structured, or to the computer. See MPEP § 2106(IV)(B)(1)(B).

No imparted functionality between the medium and the computer has been recited or identified, nor any interrelationship between the claimed recording areas and any functional activity of the computer has been recited, resulting in completely nonfunctional material. In short, the invention as set forth in claims 27-29 does not DO anything, and exemplifies non-statutory subject matter. There is no manipulation of data nor there is any transformation of data from one state to another being performed. Actually, there is no post-computer process activity found. Thus, no physical transformation is performed, and no practical application is found. Such an inputting and arithmetic manipulation of data is insufficient practical application to qualify the invention as disclosed and claimed to patent protection. *In re Alappat*, 31 USPQ 2d @ 1556-57 (not until the concept is reduced to some type of practical application, the subject matter is not entitled to patent protection).

Also the claims do not appear to correspond to a specific machine or manufacture disclosed within the specification and thus encompass any product of the class configured in any manner to perform the underlying process. Consequently, the claims 27-29 are analyzed based upon the underlying process and thus rejected as being directed to a non-statutory process.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 27-28 are rejected under 35 U.S.C. § 102(e) as being anticipated by Nakashima et al (Hereafter, Nakashima), U.S. Pat. No. 5,930,825.

Regarding claims 27-29, Nakashima teaches a recording medium comprising: a first recording area in which are recorded discrimination code information which enables the medium to be recognized as a medium adapted to a certain downloading system, download identification information for designating information to be downloaded, and one of items of serial number information set for a plurality of the recording mediums and a second recording area in which user identification information freely set by a user can be recorded, and a third area in which information can be recorded as use record information about various processings executed by the downloading system when the

recording medium is loaded in the downloading system to which the recording medium is adapted (= recording medium has a medium ID information storing area in a user data area for identification of the recording medium on which software/data is recorded) [see Abstract and Fig. 23 and Col. 14, Col. 60 to Col. 15, Line 43 and Col. 16, Line 56 to Col. 17, Line 20].

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakashima et al (Hereafter, Nakashima), U.S. Pat. No. 5,930,825 in view of Schoen et al (Hereafter, Schoen), U.S. Pat. No. 5,592,511.

Regarding claim 29, Nakashima does not explicitly teach a fourth area in which information can be recorded as fee record information of fees charged with respect to various processings executed by the downloading system when the recording medium is loaded in the downloading system to which the recording medium is adapted. However, Schoen, in the same field of recording data on a recording medium endeavor, discloses order/billings information storing on a recording medium [see Schoen, Abstract and Fig. 1 and Col. 3, Lines 8-48]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teachings of Schoen into the teachings of Nakashima in order to record billings data and protect billings data from unauthorized access.

#### ***Other References Cited***

7. The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

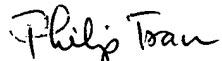
- A) Katayama et al, U.S. Pat. No. 5,715,105.
- B) Nagahama, U.S. Pat. No. 5,636,277.
- C) Takahashi et al, U.S. Pat. No. 6,195,432.
- D) Shirakawa et al, U.S. Pat. No. 5,949,953.

- E) Oshima et al, U.S. Pat. No. 5,805,551.
- F) Ohmori, U.S. Pat. No. 5,687,397.
- G) Kurihara, U. S. Pat. No. 5,784,609.
- H) Kurihara, U.S. Pat. No. 6,249,771.
- I) Yamamoto et al, U.S. Pat. No. 5,740,435.
- J) Sako et al, U.S. Pat. No. 6,215,745.

8. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (703) 872-9306. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Philip B. Tran

Art Unit 2155

September 29, 2005